

AMENDMENT AND RESPONSE UNDER 37 CFR § 1.116 -- EXPEDITED PROCEDURE
Serial Number: 09/685,449
Filing Date: October 11, 2000
Title: SALES SYSTEM WITH BUYER PRICE SELECTION

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REMARKS

This responds to the Final Office Action mailed on January 4, 2005. Claims 12, 31, 32 and 43 have been amended, and claim 16 has been canceled. Claims 31, 32 and 43 include amendments that were attempted to be made in the prior response mailed on September 27, 2004. However, the status identifier for such claims was mistakenly defined as "Previously Presented". Accordingly, Applicant respectfully resubmits such amendments. Claims 1-15, 17, 29-33 and 35-47 are now pending in this application. Applicant does not admit that the cited references are prior art and reserves the right to "swear behind" each of the cited references as provided under 37 C.F.R. 1.131.

Amendment to Specification

Applicant has made a number of amendments to the specification to correct grammar errors, incorporate appropriate reference numbers, etc. Applicant respectfully submits that no new matter has been added.

Addition of an Abstract

Applicant's copy of the filed application does not include an abstract. Accordingly, Applicant has included an abstract. Applicant respectfully submits that no new matter has been added.

§103 Rejection of the Claims

Claims 1-17, 29-33 and 35-47 were rejected under 35 USC § 103(a) as being unpatentable over Rackson et al. (U.S. 6,415,270) in view of Fisher et al (U.S. 6,243,691) and further in view of Walker et al. (U.S. 6,052,667).

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). To do that the Examiner must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.*

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The *Fine* court stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined only if there is some suggestion or incentive to do so." *Id.* (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *M.P.E.P.* § 2142 (citing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir. 1991)).

An invention can be obvious even though the suggestion to combine prior art teachings is not found in a specific reference. *In re Oetiker*, 24 USPQ2d 1443 (Fed. Cir. 1992). At the same time, however, although it is not necessary that the cited references or prior art specifically suggest making the combination, there must be some teaching somewhere which provides the suggestion or motivation to combine prior art teachings and applies that combination to solve the same or similar problem which the claimed invention addresses. One of ordinary skill in the art will be presumed to know of any such teaching. (See, e.g., *In re Nilssen*, 851 F.2d 1401, 1403, 7 USPQ2d 1500, 1502 (Fed. Cir. 1988) and *In re Wood*, 599 F.2d 1032, 1037, 202 USPQ 171, 174 (CCPA 1979)).

Claims 1-11, 17 and 29-46

Among the differences, claim 1 recites "communicating a variable price schedule for the item to the user." For claim 17, among the differences, the claim recites "means for

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communicating a variable price schedule for the item to the user, the variable price schedule including a plurality of price selections for the item.” The Office Action indicated that

Rackson and Fisher do not explicitly disclose a variable price scheduling including a plurality of price selections for an item . . . a selection of an entry in the variable price schedule . . . Walker in the same field of endeavor, discloses the concept of providing a variety of price selection and timing of the item price (See Figures 5 and 6 and col. 5 line 33 through col. 6 line 38)

Office Action at page 3.

Applicant respectfully traverses this assertion. In particular, the citations in Walker do not disclose or suggest communicating a variable price schedule for the item to the user. In contrast, the system in Walker relates to providing a consumer of a food product to substitute a selected food product for one that is “aged”. The variable price schedule having a number of price selections for the item is not communicated to the consumer. Figures 5 and 6 referred to by the Office Action are tables in a database. There is no discussion of such databases being communicated to the consumer. A choice substitution is presented to the consumer (not a variable price schedule). For example, see the description of the methods of Figures 15-17 in Walker.

Accordingly, because the cited references do not disclose or suggest all of the claim limitations, Applicant respectfully submits that the rejections of claims 1 and 17 under 35 U.S.C. §103 have been overcome. Additionally, because claims 2-11 and 29-46 depend from and further define claim 1, Applicant respectfully submits that the rejections of claims 2-11 and 29-46 under 35 U.S.C. §103 have been overcome.

Claim 8

Additionally, with regard to claim 8, among the differences, claim 8 recites “wherein acceptance of the reminder command in the receiving of a reminder command from the user is contingent on the receipt of contact information in a step of receiving contact information for the user, but wherein the presenting of the item is independent of the receipt of any contact information from the user.” The Office Action indicated that “[i]ncorporating this feature into

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Rackson et al and Fisher et al would have been obvious to a person of ordinary skill in the art so that the user can send a response indicating that the user agrees with a price.” Office Action at pages 3-4.

Applicant respectfully objects to the taking of official notice, and pursuant to M.P.E.P. § 2144.03, Applicant traverses the assertion of official notice and requests that the Examiner cite a reference that teaches the missing elements. If the Examiner cannot cite a reference that teaches the missing elements, applicant respectfully requests that the Examiner provide an affidavit that describes how the missing elements are present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, Applicant requests withdrawal of the rejection and reconsideration and allowance of claim 8.

Claims 11-16 and 47

With regard to claims 11 and 16, among the differences, such claims recite “wherein the item information area is operative to present a series of time-separated future price choices from a falling-price schedule, and wherein the future time-separated price choices are each associated with a one of the plurality of reminder request controls.” The Office Action indicated that “[i]t would have been obvious to a person of ordinary skill in the art to incorporate this feature into the disclosures of Rackson and Fisher et al with the motivation to allow a user to select an appropriate price.” Office Action at page 4. Applicant has incorporated the limitations of claim 16 into claim 12 and has canceled claim 16. Accordingly, the rejection of claim 16 is now moot. However, such rejection is now addressed with regard to claim 12.

Applicant respectfully objects to the taking of official notice, and pursuant to M.P.E.P. § 2144.03, Applicant traverses the assertion of official notice and requests that the Examiner cite a reference that teaches the missing elements. If the Examiner cannot cite a reference that teaches the missing elements, Applicant respectfully requests that the Examiner provide an affidavit that describes how the missing elements are present in the prior art. If the Examiner cannot cite a reference or provide an affidavit, applicant requests withdrawal of the rejection and reconsideration and allowance of claims 11 and 12. Additionally, because claims 13-15 and 47 depend from and further define claim 12, Applicant respectfully submits that the rejections of claims 13-15 and 47 under 35 U.S.C. §103 have been overcome.

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CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 371-2103 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

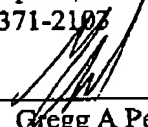
Respectfully submitted,

JEFF CHIN

By his Representatives,

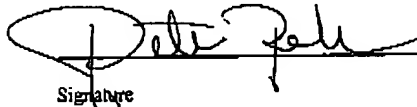
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By 
Gregg A. Peacock
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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop RCE, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 1st day of March, 2005.

Peter Rebuffoni
Name


Signature